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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,568	07/16/2001	Johanne Tremblay	004780.00001	3854

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EXAMINER

SCHULTZ, JAMES

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/904,568

Applicant(s)

TREMBLAY ET AL.

Examiner

J. Douglas Schultz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-10, 14-18 and 22-46 is/are allowed.
- 6) ☒ Claim(s) 11-13, 19-21 and 47-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Status of Application/Amendment/Claims

Applicant's response filed December 12, 2003 has been considered. Rejections and/or objections not reiterated from the previous office action mailed October 31, 2003 are hereby withdrawn. The following rejections and/or objections are either newly applied or are reiterated and are the only rejections and/or objections presently applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

Claims 11-13, 19-21 and 47-52 are rejected under 35 U.S.C. 102(e) and 103(a) as being anticipated and/or obvious by Holton et al. (U.S. Patent Number 5,569,832), and is repeated for the same reasons set forth in the Office action mailed October 31, 2003.

Applicants argue that the claims have been amended around the prior art. However, this position is not considered convincing. Claim 11, the only independent claim of the rejected claim set, has been amended to recite that the oligo claimed therein comprise a translatable portion of the claimed polynucleotides or their complements. Specifically, the claim is directed to a purified nucleic acid at least 12 nucleotides in length that hybridizes to a nucleic acid molecule in an *in situ* hybridization assay performed in a cell at 60°C in 4X SSC and 50% formamide, wherein the nucleic acid molecule comprises a translatable portion of SEQ ID No. 1, a translatable portion of SEQ ID No. 3, a sequence complementary to a translatable portion of SEQ ID No. 1, or a

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sequence complementary to a translatable portion of SEQ ID No. 3. The prior art teaches an oligo that hybridizes to a portion of SEQ ID NO: 1.

The assertion that the term “translatable” patentably distinguishes the claim from the prior art is not adopted, because the term “translatable” applies to any nucleic acid sequence under the appropriate conditions. The term “translatable” is understood to refer to any nucleic acid sequence that is “capable of being translated”. While the portion of SEQ ID NO: 1 that binds to the oligo of Holton is not a part of the coding region, and is thus not translated during the normal course of translation of SEQ ID NO: 1, this does not make such a portion altogether incapable of translation. As one of ordinary skill in the art would understand, the ability to be translated is a function of the upstream regulatory elements, such as promoters, enhancers, silencers, etc., as opposed to any inherent property of a nucleic acid oligo. It is relatively simple to cleave out a target sequence, such as that portion of SEQ ID NO: 1 that corresponds to the oligo of Holton, and insert it into a vector in order to achieve translation. Thus, the portion targeted by the oligo of Holton et al. is considered to be inherently translatable. Applicants have not argued that the cited oligo would not hybridize to SEQ ID NO: 1 as referenced. Accordingly, the oligo of Holton et al. is considered to hybridize to a portion of SEQ ID NO: 1, and to also be translatable, thus meeting all the claim limitations as recited.

Allowable Subject Matter

Claims 2-10, 14-18 and 22-46 are allowed for reasons of record.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

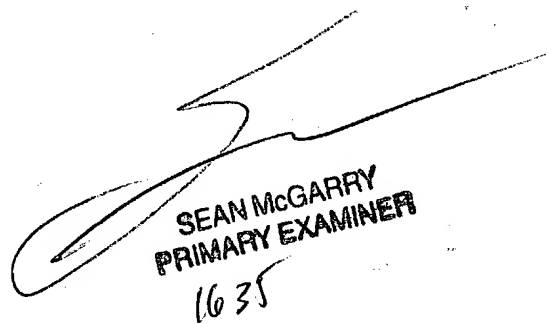
Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Douglas Schultz whose telephone number is 571-272-0763. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader can be reached on 703-308-0447. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Douglas Schultz, PhD



SEAN MCGARRY
PRIMARY EXAMINER
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